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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,183	11/18/2003	Solomon Ungashe	10709/35	4144

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EXAMINER

O'SULLIVAN, PETER G

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/716,183	<b>Applicant(s)</b> UNGASHE ET AL.	
	<b>Examiner</b> Peter G. O'Sullivan	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) 61-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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Claims 1-67 are pending in this application which should be reviewed for errors. In response to the restriction requirement, applicants elected Group II, claims 1-60, modulator compounds not containing heterocycles, without traverse. Claims 61-67 are accordingly withdrawn from consideration. In response to the requirement for the election of a single disclosed species, applicants elected the species of the compound on page 68, right column, second compound. Applicants' compounds wherein L is carbonyl, and X, Y and Z are not heterocyclic, ester, acid, sulfur or nitrogen containing are examined therewith with all other compounds held withdrawn.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 15-18, 25-28, 30-31, 32-34, 36, 40-50 and 53-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Wu et al., ("Synthesis of Substituted Amides and Their Bioactivity," Yingyong Huaxue (1995), 12(4) 80-83). Wu et al. disclose N-(4-Cl, 2-benzoylphenyl)-4-methylphenylsulfonamide and additional anticipating compounds.

Claims 1-3, 15-18, 25-28, 30-31 32-34, 36, 40-51, 53-55, 57, 58 and 61-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Schewe et al., DE 3544409, who disclose N-(4-methyl-, 2-benzoylphenyl)-4-methylphenylsulfonamide.

Claims 1-3, 5, 21, 25-28, 40-48, 56, 57 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Sannicolo, Chem. Abst. 106:175880 who

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discloses N-[2-(4-methoxy-3,5-dimethylbenzoyl)-3,5-dimethylphenyl]-4-methylbenzenesulfonamide and other anticipating compounds.

Claims 1-4, 15-18, 25-28, 30-32, 34, 36, 40-50, and 53-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Yavorskii et al., Chem Abst. 103:160483, who disclose N-(2-benzoyl-4-chlorophenyl)-4-methylbenzenesulfonamide and other anticipating compounds.

Claims 1-4, 21, 25-28, 40-48, 54-57 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Hellwinkel et al., Chem. Abst. 100:5549, who disclose 4-methyl-N-[4-methyl-2-(4-methylbenzoyl)phenyl]-benzenesulfonamide.

Claims 1-3, 6, 15-18, 25-28, 30-33, 40-50 and 53-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Fryer et al., Chem. Abst. 97:72335, who disclose N-4-chloro-2-(2,6-dichlorobenzoyl)phenyl]-4-methylbenzenesulfonamide.

Claims 1-3, 6, 15-18, 25-28, 30-33, 40-50 and 53-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Field et al., Chem Abst. 80:37186, who disclose N-2-(2-fluorobenzoyl)-4-iodophenyl]-4-methylbenzenesulfonamide.

Claims 1-4, 6, 15-18, 21, 25-28, 30-34, 36, 40-50 and 53-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Kametani et al., Chem. Abst. 73:77127, who disclose 2'-p-anisoyl-4'-chloro-p-toluenesulfonanilide and other anticipating compounds.

Claims 1-4, 15-18, 25-28, 30-34, 36, 40-50 and 53-60 are rejected under 35 U.S.C. 102(b) as being anticipated by MacDonald et al., Chem. Abst. 71:61183, who disclose 4'-bromo-2-(6-methylveratroyl)-p-toluenesulfonanilide.

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Claims 1-4, 6, 15-18, 25-28, 30-34, 36, 40-50 and 53-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Reeder et al., Chem. Abst. 70:37850, who disclose N-[4-chloro-2-fluorobenzoyl]phenyl-4-methylbenzenesulfonamide and other anticipating compounds.

Claims 1-3, 22, 23, 25-28, 32-35, 40-48 and 53-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Hromatka et al., who disclose 6'-benzoyl-alpha', alpha'-trifluoro-p-toluensulfono-m-toluidide.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 15-18, 25-28, 30-34, 36, 40-50 and 53-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al., ("Synthesis of Substituted Amides and Their Bioactivity," Yingyong Huaxue (1995), 12(4) 80-83). Wu et al. discloses

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amides useful as rice growth inhibitors, further disclosing the anticipating compounds noted above. In view of these anticipating compounds, position isomers/homologues thereof would be obvious. *In re Mills et al.* 126 U.S.P.Q. 513. It would have been *prima facie* obvious at the time the invention was made to one of ordinary skill in the art to start with the teaching of Wu et al., to make position isomers/homologues of disclosed anticipating compounds and to expect to produce compounds useful as rice inhibitors.

Claims 1-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over the teaching of Schewe, DE 3544409, combined with Tularik et al., WO 01/00579. Schewe et al. disclose compounds of formula 1 wherein R1 is Alkyl, alkoxy or hydrogen, R2 is hydrogen or halogen, X is O and R is methyl or phenyl substituted phenyl to be useful as anti-arthritis, anti-allergics, etc. (s. abstract). Schewe et al. additionally specifically disclose the anticipating N-(4-methyl-, 2-benzoylphenyl)-4-methylphenylsulfonamide. Tularik et al. add to the above by teaching generically overlapping compounds to be useful as anti-inflammatory agents useful in the treatment of rheumatoid arthritis (s. page 22, bottom). Tularik et al. disclose the equivalency of phenyl substituents corresponding to applicants' X, Y and Z disclosed by Schewe et al. to others disclosed by applicants, but not by Schewe et al. such as the equivalency of haloalkyl to alkyl or halogen. It would have been *prima facie* obvious at the time the invention was made to one of ordinary skill in the art to make applicants' compounds substituted by their phenyl substituents and to expect them to be useful as anti-inflammatory agents.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-60 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/848,836. Although the conflicting claims are not identical, they are not patentably distinct from each other because they generically overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claim is allowed.

Any inquiry concerning this communication should be directed to Peter G.

O'Sullivan at telephone number (571)272-0642.

  
PETER O'SULLIVAN  
PRIMARY EXAMINER  
GROUP 1200